

REMARKS / DISCUSSION OF ISSUES

Claims 1-6 are pending in the application. Claims 1 and 6 are the independent claims.

Rejections under 35 U.S.C. § 102

Claims 1, and 3-6 were rejected under 35 U.S.C. § 102(b) as allegedly being unpatentable over Thornton, et al. (U.S. Patent 6,574,257). While Applicants in no way concede the propriety of these rejections, the amendment to claims 1 and 6 are believed to render all claims in condition for allowance for at least the reasons set forth below.

This notwithstanding, Applicants respectfully traverse the rejections of claims 5 and 6 on the basis of inherency. Notably, the Office Action asserts:

“Since claims 5,6 recite the same or identical element limitations it is inherent to use patents Thorton et al. ‘257 to recite an optical drive, or method of using, product by process.”

Applicants respectfully submit that the basis and rationale provided in the Office Action is improper, and the rejections of claims 5 and 6 are, therefore, improper.

M.P.E.P. § 2112 IV provides that:

*EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING
TO SHOW INHERENCY*

*The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ*

323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference,' and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

(emphasis added).

Furthermore, a claim rejection must be based on objective evidence of record, and cannot be supported merely on subjective belief and unknown authority.¹ No such concrete evidence has been provided by the Examiner here, nor did the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants respectfully request that such an affidavit be provided if a rejection continues to be made without a citation of any objective evidence.

Rejections under 35 U.S.C. § 103

Claim 2 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Thornton, et al. in view of prior art. While claim 2 has been amended, subject matter from claim 2 is now incorporated into claims 1 and 6. For at least the reasons set forth below, Applicants respectfully submit that claims 1 and 6 are patentable over the applied art.

A *prima facie* case of obviousness has three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, requires some reason that the skilled artisan would modify a reference or to

¹ See, e.g., M.P.E.P. § 2144.03; In re Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); In re Zerk, 258 F.3d at 1386, 59 USPQ2d at 1697.

combine references.² The Supreme Court has, however, cautioned against the use of “rigid and mandatory formulas” particularly with regards to finding reasons prompting a person of ordinary skill in the art to combine elements in the way the claimed new invention does.³ But rather the Supreme Court suggests a broad, flexible “functional approach” to the obviousness analysis recognizing that “[i]n many fields it may be that there is little discussion of obvious techniques or combinations.”⁴ Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the same time the invention was made. In other words, a hindsight analysis is not allowed.⁵ Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims.⁶

Claim 1 recites:

An arrangement for read-out of information from an optical information carrier, comprising:

a light source configured to illuminate said information carrier;

an optical system configured to receive light reflected from the information carrier and to inject the reflected light into a vertical-cavity surface-emitting laser (VCSEL), said VCSEL having a front side for receiving said reflected light and a rear opposite said front side, wherein the VCSEL is configured to emit light through its rear;

² See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332 (Fed. Cir. 2005) (“[S]imply identifying all of the elements in a claim in the prior art does not render a claim obvious.”).

³ See KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007) (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”).

⁴ Id. See also Id. at 1743 F. 3d 1356 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense”) (emphasis in original).

⁵ See Amgen, Inc. v. Chugai Pharm. Co., 927 F.2d 1200 (Fed. Cir. 1991) (“Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious.”).

⁶ See In re Wilson, 424 F.2d 1382 (C.C.P.A. 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

a photodetector is provided adjacent said rear to detect light emitted through the rear of the VCSEL; and

a polarizer arranged between said rear of the VCSEL and said photodetector.

The Office Action asserts that it is within the purview of one of ordinary skill in the art to:

“recognize the polarizer has been used in the laser art, and having a polarizer polarizing light prior to receive by the detector is within one skill in the art. Furthermore, Prior Art (Fig. 2) shows the use of polarizer arranged between laser beam output and the photodetector to allow only certain light to reach the detector.”

In *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727; 82 U.S.P.Q.2D 1385 (2007), the Court stated “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (CA6 1964))).” Moreover, if there is no suggestion to combine the teachings of the applied art, other than the use of Applicants’ invention as a template for its own reconstruction, a rejection for obviousness is improper. *Ex parte Crawford, et al.* Appeal 20062429, May 30, 2007. In furtherance to the need for the suggestion to combine the teachings of the applied art, it is established that rejections on obviousness grounds cannot be sustained by mere conclusory statements: instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex*, 127 S. Ct. at 1741.

Applicants respectfully submit that the rejection impermissively relies on hindsight. To this end, there is no basis for the rejection excepting the use of the arrangement of a polarizer as set forth in Fig. 2 of the application with the baseless assertion that the subject matter is obvious. First of all, the arrangement of Fig. 2 of the

filed application is wholly inefficient as light from only one side of the VCSEL is used. Moreover, the arrangement is comparatively complex. By contrast, Applicants have recognized the reduced complexity and unencumbered benefit of providing the polarizer on light-emitting side of the VCSEL, and emission of light from the other side of the VCSEL concurrently. No extrinsic evidence has been provided in support of the asserted position of obviousness, rendering the rejection improperly biased by hindsight. Applicants therefore respectfully submit that but for the use of their claimed subject matter as templates for their own reconstruction, the subject matter of claims 1 and 6, as amended, would not have been obvious in view of the art available at the time of Applicants' invention.

Accordingly, and for at least the reasons set forth above, Applicants respectfully submit that claims 1 and 6 are patentable over the applied art at least because a prima facie case of obviousness has not been established. Moreover, claims 2-5, which depend from claim 1, are also patentable for at least the same reasons and in view of their additionally recited subject matter.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

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by: William S. Francos (Reg. No. 38,456)

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